

REMARKS/ARGUMENTS

This Amendment is submitted in response to the first Official Action of July 1, 2004. Reconsideration and allowance of claims 1-10 are respectfully requested.

Claims 1-5 and 10-12 have been rejected under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent 6,447,220. The Office Action contends that the above-identified claims from the present application, if allowed, would improperly extend the "right to exclude" already granted in the '220 patent.

Applicant's attorney respectfully disagrees with the double patenting rejection. The subject matter claimed in the subject application is **not** fully disclosed in the '220 patent and it appears that the Examiner may have overlooked the important limitations of claims 1 and 10, namely, that a control means is provided for selectively longitudinally translating the cutting head member axially along the boring bar member or radially translating the slide and tool bit of the annular cutting head member with respect to the longitudinal axis of the boring bar member. No such control means is either disclosed or suggested in the '220 patent.

In order to better emphasize the control means, claim 1 has been amended to indicate that during longitudinal translation of the cutting head member, radial movement of the slide and tool bit is inhibited and that during radial translation of the slide and tool bit, axial translation of the cutting head member is inhibited. A similar amendment has been made to claim 10.

In that there is no teaching or suggestion in the '220 patent for the recited "control means", the double patenting rejection is believed to be traversed.

Claims 1, 3-5, 7 and 10 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,030,041 to Marron. This rejection is also respectfully traverse.

It is well understood that for a patent to anticipate a claim, the patent must teach each and every limitation of the claim sought to be anticipated. The Marron patent does not teach element (e) of independent claim 1 nor element (c) of independent claim 10. In applicant's arrangement, a single drive means is used to selectively provide either axial

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movement of the cutting head along the length of the bore bar or to impart radial translation of a tool slide and cutting head. The feed motor 18 that is coupled to the threaded lead screw 16 effects axial translation of the cutting head assembly 26 along the length of the bore bar when the control means, including the feed control shaft 102 is manually set in a first position. Radial translation of the tool slide and tool bit is inhibited at this time. By turning the control shaft 102 to a second position, axial displacement of the cutting head is prevented while rotation of the threaded lead screw 16 causes radial displacement of the slide and tool bit. Thus, in the present invention, the same threaded lead screw 16 that runs down the length of the bore bar operates through the recited control means to feed axially and radially although not simultaneously. In the Marron '041 patent, the threaded lead screw 38 that runs down the length of the bar 26 only feeds the cutting head assembly 35 in the axial direction. The feed screw 66 in the Marron patent runs radially off of a support arm 184. As stated at column 4, lines 57 through column 5, line 1, the shaft 66 will either be manually turned by the machinist or, alternatively, at second drive motor can be used to rotate the shaft 66. It is clear, however, that a single second drive means is not used to selectively translate a cutting head axially and a tool bit radially as claimed by applicant.

For the reasons advanced, then, the rejection based on 35 U.S.C. §102 is inappropriate and should be withdrawn.

Claims 2 and 6 have been rejection under 35 U.S.C. §103(a) as being unpatentable over the Marron reference. In that it has been shown that claim 1 is patentable over the Marron reference, dependent claims 2 and 6 also may now be allowed.

It has been noted that claims 8 and 9 have been found to define patentable subject matter when rewritten in independent form so as to include all of the limitations of the base claim and any intervening claims. However, because independent claim 1 is deemed to be allowable for the reasons already advanced, there is no need to present claims 8 and 9 in independent form at this time.

By way of summary, then, it has been shown how the claims of the subject application differ from those in U.S. Patent 6,447,220 so that the double patenting

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rejection is inappropriate. Further, independent claims 1 and 10, as how amended, more clearly distinguish those claims from the teachings of the Marron '041 patent so that it cannot be said that those claims are anticipated or obvious in view Marron.

All of the claims remaining in the application are now believed to be in condition for allowance and a Notice to that effect is most respectfully solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing in response to the Official Action of February 18, 2004, in application Serial No. 10/758,627, filed on January 15, 2004, of Donato L. Ricci entitled "Radial Feed Facing Head for Boring Bar" is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, postage prepaid, on September 7, 2004.

Date of Signature: September 7, 2004.

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